

## **REMARKS**

1. In response to the Office Action mailed April 24, 2009, Applicants respectfully request reconsideration. Claims 1-11 and 19-23 were last presented for examination. In the outstanding Office Action, claims 1-11 and 19-23 were rejected. By the foregoing Amendments, claims 1-3, 5-6, 9, 11, 20, and 22-23 have been amended. Claims 39-47 have been added, and claims 4, 7-8, 12-19, 21, and 24-38 have been cancelled. Upon entry of this paper, claims 1-3, 5-6, 9-11, 20, 22-23, and 39-47 will be pending in this application. Of these twenty (20) claims, two (2) claims (claims 1 and 39) are independent claims.

2. Based upon the above Amendments and following Remarks, Applicants respectfully request that all outstanding objections and rejections be reconsidered, and that they be withdrawn.

### ***Claim Rejections under §112***

3. The Examiner rejected claims 2-3 and 6-9 under 35 U.S.C. 112, second paragraph, for allegedly being indefinite. The Examiner states that “[c]laim 2 is vague as it is unclear if the implantable tissue stimulating device is a cochlear electrode array, further includes a cochlear electrode array, or if the elongate carrier member is the cochlear electrode array.” (See, Office Action, page 2.)

4. Applicants’ amended claim 2, above, now recites “[t]he implantable tissue stimulating device of claim 1, further comprising: a cochlear implant electrode assembly comprising the elongate carrier member and the plurality of electrodes.” Thus, Applicants respectfully request that the stated rejection of claims 2-3 and 6-9 be reconsidered and withdrawn.

### ***Claim Rejections under §102***

5. The Examiner has rejected claims 1, 4-5 and 9-11 under 35 U.S.C. 102(e) as allegedly being anticipated by U.S. Publication No. 2002/0156513 to Borkan (hereinafter, “Borkan”).

6. Borkan is directed to catheters used for tissue stimulation. (See, Borkan, Abstract.) Borkan discloses a catheter lead 50 having a passage 60 therein, and discloses that a stilet 61

may be used in passage 60 to straighten a curved end of the catheter lead. (*See*, Borkan, paragraphs 50 and 53.) Borkan also discloses that optical (i.e., fiberoptic) channels 70 and 72 may be disposed in passage 60 of catheter lead 50 (i.e., electrode catheter 50), with one of the optical channels being used as a light source and the other being used as a lens for a monitoring device. (*See*, Borkan, paragraphs 59.)

7. Applicants' amended claim 1 recites "an optic fiber stiffening element comprising one or more optic fibers configured to bias the elongate carrier member into a first configuration when disposed in said at least a first lumen." (*See*, Applicants' claim 1, above.) While Borkan discloses optical channels 70 and 72, as noted above, Applicants submit that Borkan fails to disclose that those optical channels are an optic fiber stiffening element. That is, Borkan does not disclose that channels 70 and 72 are used to straighten catheter lead 50 of Borkan. Rather, Borkan discloses a separate stilet 61 used to straighten an end of catheter lead 50 of Borkan. (*See*, Borkan, paragraph 53.)

8. As such, Applicants submit that Borkan fails to anticipate or render obvious "an optic fiber stiffening element comprising one or more optic fibers configured to bias the elongate carrier member into a first configuration when disposed in said at least a first lumen," as recited in Applicants' claim 1, above. Thus, Applicants respectfully request that the rejection of claim 1 under 35 U.S.C. 102 over Borkan be reconsidered and withdrawn.

### ***Claim Rejections under §103***

9. The Examiner rejected claims 1-11 and 19-23 under 35 U.S.C. 103(a) as allegedly unpatentable over U.S. Publication No. 2004/0147825 to Milojevic et al. (hereinafter, "Milojevic") in view of U.S. Patent No. 5,394,865 to Salerno et al. (hereinafter, "Salerno"). Applicants respectfully request that the Examiner reconsider and withdraw these rejections for at least the following reasons.

***Claim 1***

10. As stated by the Supreme Court in *KSR International Co. v. Teleflex Inc.*, “a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.” (127 S.Ct. 1727, 1741 (2007).) The Supreme Court recognized that “rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some ***articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.***” (See *KSR*, 127 S.Ct. at 1741 (citing *In re Kahn*, 441 F.3d 977, 988 (C.A.Fed. 2006); emphasis added.) Without addressing the propriety of the Examiner’s combination of Milojevic and Salerno, Applicants respectfully assert that even if the references were combined as proposed by the Examiner, the resulting combination would still fail to anticipate or render obvious Applicants’ claim 1, as amended.

11. As amended, Applicants’ claim 1 recites “an optic fiber stiffening element comprising one or more optic fibers configured to bias the elongate carrier member into a first configuration when disposed in said at least a first lumen.” (See, Applicants’ amended claim 1, above.)

12. In rejecting claim 1 prior to the present amendments, the Examiner recognized that Milojevic fails to disclose a “stylet having one or more optic fibres.” (See, Office Action, page 4). The Examiner, however, relied upon Salerno in attempting to cure this deficiency of Milojevic.

13. Salerno discloses a medical or dental instrument having an illuminated, malleable stylet encasing therein at least one flexible fiber optic cable. (See, Salerno, col. 1, lines 11-15, 45-47, 57-58, and 66-67.) Regarding the “stylet”, Salerno specifically discloses a probe 14 that includes two coaxially-arranged, flexible, fiber optic cables 18 and 22, and flexible or malleable materials 20 and 24 that encase fiber optic cables 18 and 22, respectively. (See, Salerno, col. 1, lines 66-67; col. 2, lines 36-50; and col. 5, lines 6-8.) Salerno specifically states that “[t]he fiber optic cables 18, 22 are flexible at room temperature.” (See, Salerno, col. 3, lines 50-51.)

14. The Examiner states that “[Salerno] discloses a fiber view lighted stylet that includes multiple fibre optic cables capable of transmitting light and visual information. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the stylet as taught by Milojevic with [a] lighted stylus [*sic*] as taught by [Salerno], since

such a modification would provide the predictable results of a stylus [*sic*] with optic fibers.” (See, Office Action, page 4.) However, Applicants’ amended claim 1 does not recite merely a stylet **with** optic fibers, but “an optic fiber stiffening element comprising one or more optic fibers configured to bias the elongate carrier member into a first configuration when disposed in said at least a first lumen.” (See, Applicants’ amended claim 1, above.) In addition, Applicants submit that the proposed combination of Milojevic and Salerno does not render obvious those features of Applicants’ amended claim 1 because the “stylet” of Salerno is not “an optic fiber stiffening element,” as recited in Applicants’ amended claim 1.

15. While Salerno uses the term “stylet”, the “stylet” disclosed by Salerno is not a “stiffening element,” as recited in Applicants’ claim 1. Applicants note that Merriam-Webster’s Online Dictionary lists multiple definitions for the word “stylet”. Two of those definitions are “a slender surgical probe” and “a thin wire inserted into a catheter to maintain rigidity or into a hollow needle to maintain patency.” (See, Merriam-Webster’s Online Dictionary, “stylet”, 1a and 1b.) Applicants submit that the “stylet” of Salerno falls under the former of those two definitions, since Salerno states, for example, that “[t]he instrument has a malleable stylet (**or probe**) . . . .” (See, Salerno, col. 1, lines 66-67.) Further, Salerno describes that the “malleable stylet (or probe)” may be part of an instrument used in “an intubation procedure.” (See, Salerno, col. 1, lines 65-67; and col. 5, line 26-33.) Describing an intubation procedure, Salerno specifically discloses that “[t]he probe containing the fiber optic cables is bent to the desired conformation. It is then placed into the mouth of the subject and directed down the throat to the lower pharynx to illuminate the local area around the epiglottal area properly.” (See, Salerno, col. 5, lines 29-33.) Applicants therefore submit that Salerno fails to disclose that the probe is used as a stiffening element.

16. Further demonstrating that probe 14 is not a stiffening element, but is instead malleable, are the descriptions of the components of probe 14, i.e., fiber optic cables 18 and 22 and encasing materials 20 and 24. (See, Salerno, col. 2, lines 36-46.) In particular, Salerno specifically describes its fiber optic cables as **flexible**. (See, Salerno, col. 1, line 47; col. 3, lines 50-51; col. 5, lines 58-59; and col. 6, lines 55-56.) Similarly, Salerno describes encasing materials 20 and 24 as flexible or malleable. (See, Salerno, col. 5, lines 6-8; and col. 2, lines 43-45.) Also, as noted above, Salerno describes “a **malleable** stylet (or probe).” (See, Salerno, col.

1, lines 66-67; emphasis added.) As such, Applicants submit that Salerno describes both the probe and its components as flexible or malleable. Applicants therefore submit that probe 14 is not “an optic fiber stiffening element,” as recited in Applicants’ claim 1, above.

17. Additionally, Applicants’ claim 1, as amended, recites “an optic fiber stiffening element comprising *one or more optic fibers configured to bias the elongate carrier member* into a first configuration when disposed in said at least a first lumen.” (See, Applicants’ claim 1, above; emphasis added.) However, Applicants submit that Salerno fails to disclose that fiber optic cables 18 and 22 are themselves configured to bias the configuration of another element. Rather, as noted above, Salerno discloses flexible fiber optic cables. In addition, the flexible fiber optic cables of Salerno appear to conform to the shape given to them by at least one malleable encasing material. (See, Salerno, col. 1, lines 57-58; col. 2, lines 36-46; and col. 3, lines 50-68.)

18. Accordingly, for at least the above-discussed reasons, Applicants submit that the proposed combination of Milojevic and Salerno does not anticipate nor render obvious “an optic fiber stiffening element comprising one or more optic fibers configured to bias the elongate carrier member into a first configuration when disposed in said at least a first lumen,” as recited in Applicants’ amended claim 1. Thus, Applicants respectfully request that the rejection of Applicants’ claim 1 be reconsidered and withdrawn.

### ***Claim 39***

19. Applicants’ new claim 39 recites “biasing the elongate carrier member into a first configuration using one or more optic fibers as a stiffening element within the elongate carrier member.” (See, Applicants’ new claim 39, above.) As such, Applicants respectfully submit that claim 39 is allowable over the cited references at least for reasons similar to those set forth above with regard to claim 1.

### ***Dependent claims***

20. The dependent claims incorporate all the subject matter of their respective independent claims and add additional subject matter which makes them independently patentable over the

art of record. Accordingly, Applicants respectfully assert that the dependent claims are also allowable over the art of record.

***Conclusion***

21. In view of the foregoing, this application should be in condition for allowance. A notice to this effect is respectfully requested.

22. Applicants reserve the right to pursue any cancelled claims or other subject matter disclosed in this application in a continuation or divisional application. Any cancellations and amendments of above claims, therefore, are not to be construed as an admission regarding the patentability of any claims and Applicants reserve the right to pursue such claims in a continuation or divisional application.

Dated: September 24, 2009

Respectfully submitted,

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